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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	

ROBERT W BECKER & ASSOCIATES QM32/0328

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SUITE B
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DEXTER, C
EXAMINER

3724	
ART UNIT	PAPER NUMBER

03/28/00

9

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/251,781

Applicant(s)
Supe-Dienes

Examiner
Clark F. Dexter

Group Art Unit
3724



☒ Responsive to communication(s) filed on Jan 19, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 18-34 is/are pending in the application.

Of the above, claim(s) 22-34 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 18-21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I (claims 18-23) and Species A corresponding to Figure 1 (claims 18-21, 24 and 26-31) in the response filed January 19, 2000 (paper no. 8) is acknowledged. Thus, the election of both Group I and Species A results in an election of claims 18-21 for prosecution. The traversal is on the grounds that "the application by virtue of having a generic claim that reads on all four "inventions" encompasses only ONE INVENTION with a common inventive features." Applicant further argues that "[T]he four 'inventions' identified by the Examiner are SPECIES of the invention but not separate inventions." This is not found persuasive for the following reasons.

The restriction in the present application which is directed to Groups I-IV is not an election of species since species must be mutually exclusive. Rather, the restriction of Groups I-IV is a restriction between inventions; specifically subcombinations useable together. Therefore, claim 18 is not a generic claim with respect to Groups I-IV, but rather a common claim (i.e., a claim which claims subject matter which is common to all the groups and thus is not separable from any of the groups). Further, whether a claim is presented in independent or dependent form is of little consequence. All claims are considered as independent claims. Dependent claims are merely independent claims written in abbreviated or shorthand form. Thus, the grouping of the claims is based on the claimed subject matter and is not based on the form in which the claims are

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presented. If applicant's position is that Groups I-IV are not independent or distinct, such a statement will be considered if applicant submits evidence or identifies such evidence now of record showing the species to be obvious variants or clearly admits on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

It is noted that, as stated in the restriction requirement (paper #7), if claim 18 is determined to be patentable, rejoinder of the claims dependent therefrom will be considered.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 22-34 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions and species.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statement filed June 14, 1999 has been received and the references listed thereon have been considered.

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Drawings

5. The drawings are objected to because of the following informalities:

In Figure 1, it seems that the feature located in the space between features 24 and 27 should be labeled for clarity (it appears to be a drive piston rod);

In Figure 2, numeral 27 appears to be inaccurate, and it seems that it should be changed to --28-- to indicate a modified pneumatic connector, and numeral --27-- should be added to indicate the pneumatic drive in a similar manner to Figure 1.

Correction is required.

Specification

6. The disclosure is objected to because of the following informalities:

On page 7, lines 14-15, the brief description is unclear as to which embodiment it refers.

On page 9, line 10, "26" appears to be inaccurate and should be changed to --16--; in line 18, it seems that "onto" should read --of-- for clarity; in line 19, "tensioned" renders the description unclear and appears to be inaccurate, and it seems that it should be changed to --compressed-- or the like.

On page 10, line 1, it seems that --rod-- is missing after "piston" and should be inserted for clarity.

On page 11, line 9, it seems that "is" is incorrect and should read --its--.

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On page 12, lines 1[✓] and 6[✓], “29” appears to be inaccurate and it seems that it should read --39--; in line 2, “33” is not shown and appears to be inaccurate, and it seems that it should be changed to --23--. Appropriate correction is required.

7. The specification is objected to as failing to provide clear support for the claim terminology. 37 CFR § 1.75(d)(1) requires that terms and phrases used in the claims find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. Specifically, the terms “advancing device” as set forth in claim 1, line 7, “advancing piston”[✓] as set forth in claim 1, line 10, and “pressing device” as set forth in claim 1, line 19 do not appear in the specification. ← *

Claim Rejections - 35 USC § 112

8. Claims 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 18, line 3[✓], “at” renders the limitation vague, and it seems that it should read --on-- or --to-- or the like; in line 6[✓], “adapted to receive” is vague and indefinite as to how the blade holding member is “adapted”; in line 7[✓], “an advancing device” is vague and indefinite as to what disclosed structure it refers; in line 10, “an advancing piston” is vague and indefinite as to what disclosed structure it refers; in line 19, “a pressing device” is vague and indefinite as to what disclosed structure it refers. ← *

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In claim 19, line 3, ✓“between ... the circular blade” is vague and indefinite since the invention is being defined in terms of the circular blade which is not positively set forth as part of the claimed invention.

Prior Art

9. Further consideration of the claimed invention with respect to the prior art will be given upon clarification of the claimed invention.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
March 27, 2000